

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Pedro Philogene, et al.

Serial No.: 10/715,339

Filed: November 17, 2003

**For: ROBOTICALLY CONTROLLED
SURGICAL INSTRUMENTS**

)
) **Confirmation No.:** 2403

)
) **Group Art Unit:** 3733

)
) **Examiner:** Philogene, Pedro

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This letter is in response to the Office Action, dated August 27, 2008. Claims 1-72 remain pending in this application, claims 45-72 of which have been withdrawn from consideration. None of claims 1-44 has been amended.

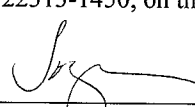
Claim Rejections-35 U.S.C. §103

Claims 1-44 stand rejected under 35 U.S.C. §103, as being obvious over U.S. Patent No. 6,840,938 ("Morley") in view of U.S. Patent No. 4,887,612 ("Esser").

CERTIFICATE OF TRANSMISSION

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below via the USPTO EFS-Web filing system..

11/26/08
Date of Deposit


Jocelyn L. Lee

Applicant respectfully traverses this rejection, since no proper combination of Morley and Esser discloses, teaches, or suggests the combination of elements required by these claims.

In particular, the Examiner concludes that Morley discloses a “linkage (34, 74) having a first end connected by a pivot joint (A1).” Applicant does not understand this characterization. The linkage 34 is not associated with the wrist body 74 in Morley. Rather, the linkage 34 moves the entire tool 28 in space (see col. 7, lines 33-47), while the wrist body 74 forms a part of the tool 28 that supports the jaws (see col. 8, lines 49-55). They do not appear to interact with other.

Furthermore, the pivot point A1 that the Examiner speaks of is not associated with the pivoting between jaw members. Rather, the pivot point A1 is integrated into a wrist joint that is used to move the entire end effector assembly. Thus, to the extent that the wrist body 74 can be considered a linkage, its one end may be coupled to the pivot point A1, but it is clearly not coupled to either of the jaw members through the pivot point A1. Rather, it is coupled in the proximal direction away from the jaw members to the shaft of the arm 62 through the pivot point A1 (see Fig. 5B). In sum, the wrist body 74 is not a linkage that is used to open and close the jaw members relative to each other, but rather is an element that allows the entire jaw member assembly to move much like a wrist.

Using Esser, the Examiner proposes that the wrist body 74 can somehow be transformed into a linkage used to increase the mechanical advantage of the jaw members relative to each other. However, the wrist body 74 is specifically designed as part of the wrist joint. Clearly, there is no suggestion to eliminate the wrist joint in

Morley by transforming the wrist body 74 into a linkage between the jaw members. Furthermore, in a very conclusory manner, the Examiner merely stated that Esser discloses a slot and an accommodating mechanism that can be incorporated into the device of Morley to increase the mechanical advantage. The Examiner has not explained how the slot and accommodating mechanism disclosed in Esser could be used to transform the wrist body 74 into a linkage used to increase the mechanical advantage between the jaw members. If the Examiner believes otherwise, he is requested to specifically point out how the wrist body 74 can be transformed into the claimed language using the disparate teachings of Esser.

Notwithstanding the foregoing, the claims require more than merely providing a mechanical advantage to jaw members.

For example, independent claim 1 requires the linkage to provide “increasing leverage to increase the force applied to an item grasped between the jaws . . .” Independent claim 12 requires “an accommodating mechanism that allows continued movement of the drive mechanism toward a locked position even after the jaws contact a larger item so that the drive mechanism can move to the locked position when grasping items of different sizes.” Independent claim 28 requires “an accommodating means that allows continued movement of the driving means towards a locked position even after the grasping means contact a larger item so that the driving means can move to the locking position when the grasping means grasps items of different sizes.” Independent claim 29 requires an “accommodating mechanism interacting with said drive mechanism and work members and that allows the work members to be closed

beyond a maximum grasping position so that the work members can grasp items of various sizes.”

Independent claim 20 requires the step “increasing leverage to the jaws to increase the force applied to the item grasped between the jaws.” Independent claim 24 requires the steps “increasing the force applied to the item grasped between the jaws, the force being applied to the grasped item as the jaws close to a locked position,” and “allowing a closing force to be applied to the grasped item corresponding to the size of the item being grasped.” Independent claim 37 requires the step “increasing leverage to the jaws beyond the initial contact position to increase the force applied to the item grasped between the jaws with the magnitude of applied force being proportional to the size of the item being grasped.” Independent claim 42 requires the steps “increasing the force applied to the item grasped between the jaws, the force being applied to the grasped item as the jaws close to a locked position,” and “providing a force at the locked position that is proportional to the size of the item being grasped.” Independent claim 44 requires the step “increasing leverage to the end effector beyond the initial contact position to increase the force applied to the item grasped by the end effector with the magnitude of the applied force, after initial contact being proportional to the size of the item being grasped.”

As such, Applicant respectfully requests that the Examiner specifically address these limitations and point out where in the prior art references that they can be found.

Thus, Applicant submits that independent claims 1, 12, 20, 24, 28, 29, 37, 42, and 44, as well as the claims depending therefrom (claims 2-11, 13-16, 21-23, 25-27,

32, 33, 36, 38-40, and 43), are not obvious over Morley and Esser, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: November 26, 2008

By:

A handwritten signature in black ink, appearing to read 'Michael J. Bolan', is written over a horizontal line.

Michael J. Bolan
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